

Application No. 09/605,695
Reply to Office Action dated December 7, 2005
Reply to Office Action of June 9, 2005

"targeting users" and "tracking user activity." (Office Action, page 22, paragraph 2). Accordingly, it would be redundant to combine the features of Ginter with the teachings of Gerace, i.e., adding the features of tracking and targeting users, already disclosed in Ginter. (See MPEP § 2143.01, "the Prior Art Must Suggest the Desirability of the Claimed Invention," page 2100-125, col. 1 (February 2003)). Therefore, Applicant respectfully submits that the motivation used by the Examiner to combine the teachings of Ginter with Gerace is improper. Accordingly, Applicant submits that the combination of Ginter and Gerace cannot be maintained.

II. The motivation used by the Examiner to support the combination of Ginter and Gerace is not suggested by the prior art.

Applicant further respectfully submits that the Examiner's asserted motivation, "to better present a user with information of interest," is not suggested in either Ginter or Gerace. (See MPEP § 2143.01, "the Prior Art Must Suggest the Desirability of the Claimed Invention," page 2100-129, col. 2 (May 2004)). Accordingly, Applicant submits that the combination of Ginter and Gerace cannot be maintained.

III. The proposed combination still does not yield Applicant's claimed invention.

Even, *assuming arguendo*, the combination of Ginter and Gerace could be properly maintained, the combination still fails to yield Applicant's claimed invention. The Examiner states that "Gerace further discloses identifying specific media objects based on user activity with that same object or another object and targeting the specific media object to the user." (Office Action, page 22, paragraph 5). The Examiner's rejection does not state how each and every element of the claims is disclosed or rendered obvious by the disclosures of Ginter and Gerace. According to the MPEP, "[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. [citation omitted], 'All words in a claim must be considered in judging the patentability of that claim against the prior art.' [citation omitted]." (MPEP § 2143.03, "All Claim Limitations Must Be Taught or Suggested," page 2100-108, col. 2 (May 2004)).

Independent claims 1, 9, 17, and 27 recite systems and methods for targeting media to a user based on user interaction with a media object. Independent claim 1

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further recites that a mediator provides to "at least one user at least a second media object based upon said user activity information correlated with at least said first media object." Ginter and Gerace, either alone or when properly combined, do not teach or suggest a system as recited in claim 1.

Independent claim 9 further recites "a coding system for assigning user activity information" to "at least one of said stored media objects to create a profile for said at least one of said stored media objects" and "a mediator for selecting at least one of said stored media objects having a media object profile matching at least one characteristic of said profile of said user requested media object." Ginter and Gerace, either alone or when properly combined, do not teach or suggest a system as recited in claim 9.

Independent claim 17 further recites the steps of "matching at least one characteristic of said media object profile of said user requested media object with said media object profile of at least a second media object" and "delivering said user requested media object with at least said second media object having an object profile matching at least one characteristic of said media object profile of said user requested media object." Ginter and Gerace, either alone or when properly combined, do not teach or suggest a method as recited in claim 17.

Independent claim 25 further recites the steps of "detaching and decoding said coded header to obtain said profile, said profile containing user activity information generated by interaction with said media object by users" and "targeting other media based on said profile." Ginter and Gerace, either alone or when properly combined, do not teach or suggest a method as recited in claim 25.

Independent claim 27 further recites the steps of combining a "media object profile with said at least one user requested media object to create a smart media object" and "selecting at least one smart media object having a media object profile matching at least one characteristic of said media object profile of said user requested media object and delivering said user requested media object with said at least one selected smart media object." Ginter and Gerace, either alone or when properly combined, do not teach or suggest a method as recited in claim 27.

Applicant respectfully submits that the combination of Ginter and Gerace also

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fails to teach or suggest all of the elements of independent claims 22, 29, and 32, and that the Office Action does not state how each and every element of each claim is either disclosed or rendered obvious by the combination. Accordingly, Applicant submits that the rejection of claims 1-7, 9-15, 17-20, 22, 23, and 25-37 under 35 U.S.C. § 103(a) as being obvious over Ginter in view of Gerace has been overcome.

IV. The combination of elements from Ginter with elements from Gerace would require undue experimentation.

Applicant submits that combining the disclosures of Ginter and Gerace in an attempt to derive Applicant's claimed invention would require undue experimentation. (See MPEP § 2121.01 (May 2004)("[t]he disclosure in an assertedly anticipating reference must provide an enabling disclosure of the desired subject matter; mere naming or description of the subject matter is insufficient, if it cannot be produced without undue experimentation")).

Ginter discloses a system and method for rights management and control "to ensure that information is accessed and used only in authorized ways, and maintain the integrity, availability, and/or confidentiality of the information." (Ginter, Abstract, lines 5-7). Ginter creates "a virtual distribution environment (VDE) that may enforce a secure chain of handling and control, for example, to control and/or meter or otherwise monitor use of electronically stored or disseminated information." (Ginter, Abstract, lines 5-7). Gerace discloses a system that provides "targeting of appropriate audience based on psychographic or behavioral profiles of end users." (Gerace, Abstract, lines 1-3). Applicant respectfully submits that attempting to modify the Ginter system of rights management to additionally function to target audiences based on behavioral profiles according to the Gerace system would require undue experimentation. Accordingly, Applicant submits that the combination of Ginter and Gerace cannot be maintained.

V. The proposed combination still does not yield the subject matter of many of Applicant's dependent claims.

Applicant submits that not only does the Examiner's proposed combination of Ginter and Gerace fail to teach or suggest the subject matter of Applicant's independent claims, the combination also fails to yield the subject matter of many of Applicant's dependent claims. For example only, Applicant submits that Ginter and Gerace,

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whether alone or in proper combination, fail to teach or suggest the subject matter of any one of claims 33-37. The Examiner states that "Ginter lacks explicit recitation of the elements and limitations of claims 33-37, even though Ginter suggests the same." (See Office Action, page 21, paragraph 3). The Examiner does not provide any details as to how the subject matter of claims 33-37 is disclosed or rendered obvious by Ginter and Gerace. Accordingly, Applicant respectfully submits that the Examiner has not established a *prima facie* case of obviousness at least with respect to claims 33-37.

Applicant submits that independent claims 1, 9, 17, 22, 25, 27, 29, and 32 are allowable and that dependent claims 2-7, 10-15, 18-21, 23, 26, 28, 30, 31, and 33-37 dependent from one of independent claims 1, 9, 17, 22, 25, 27, 29, and 32, or claims dependent therefrom, are allowable at least due to their dependency from an allowable independent claim.

In view of the foregoing remarks, it is respectfully submitted that the claims are patentable. Therefore, it is requested that the Examiner reconsider the outstanding rejections in view of the preceding comments. Issuance of a timely Notice of Allowance of the claims is earnestly solicited.

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this reply, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 50-1068.

Respectfully submitted,

MARTIN & FERRARO, LLP

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By: 

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